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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,830	03/18/2004	Frank D. Moore	M122003_FM	7043

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EXAMINER	
CHEUNG, VICTOR	
ART UNIT	PAPER NUMBER
3714	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/803,830	MOORE, FRANK D.	
	Examiner	Art Unit	
	Victor Cheung	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *3-18-2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claim 16 recites the limitation "a desired public opinion of the number-by-number lotto game" in line 14. The limitation is not described in the specification in any way to give a reasonable interpretation of what the desired public opinion is.

Claim Objections

2. Claims 1, 2, 4-6, 10, and 16 are objected to because of the following informalities:

- Claim 1, Line 4: "net intake" should be –a net intake–.
- Claim 1, Lines 6-8: "the large portion of the net intake from the sale of the lotto tickets which the top jackpot is structured to receive predeterminedly" should be –the predetermined large portion of the net intake from the sale of the lotto tickets–.
- Claim 1, Line 12: "gaming methods" should be –the gaming method–.
- Claim 2, Line 2; Claim 16, line 11: "the large portion" should be –the predetermined large potion–.
- Claim 2, Line 3; Claim 16, Line 12: "the small portion" should be –the predetermined small portion–.

- Claim 2, Line 5; Claim 16, Line 14: "applicable lotto-host" should be –an applicable lotto-host–.
- Claim 2, Line 7; Claim 4, Line 4; Claim 5, Line 6; Claim 6, Line 6: "the base jackpots" should be –the one or more base jackpots–.
- Claim 10, Line 6: "respectively" should be removed.
- Claim 16, Line 4: "net intake" should be –a net intake–.
- Claim 16, Lines 6-7: "the large portion of the net intake form the sale of the lotto tickets which the top jackpot is structured to receive predeteminedly" should be –the predetermined large portion of the net intake from the sale of the lotto tickets--.
- Claim 16, Line 17; Claim 17, Lines 4, 5; Claim 18, Lines 3, 4, 6, 12; Claim 19, Line 6; Claim 20, Lines 2, 5: "pickup" should be –pickup truck--.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Re Claims 1-15: Claim 1 is rejected under 35 U.S.C. 101 because it is drawn to more than one statutory category of invention. 35 U.S.C. 101 allows a single claim to be drawn to

a single statutory class. However, claim 1 includes a lotto game with jackpots (line 2; a manufacture) as well as a gaming method (line 9; a process).

Claims 2-15 are dependent on claim 1.

Re Claims 16-20: Claim 16 is rejected under 35 U.S.C. 101 because it is drawn to more than one statutory category of invention. 35 U.S.C. 101 allows a single claim to be drawn to a single statutory class. However, claim 16 includes a lotto game with jackpots (line 2; a manufacture) as well as a gaming method (line 9; a process) and an advertisement method (line 16; a process).

Claims 17-20 are dependent on claim 16.

It is noted that upon clarification of the claims, the examiner will revisit the claims to determine if they are statutory.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 1-20: Claims 1 and 16, with dependent claims 2-15 and 7-20, respectively, each include more than one statutory category of invention. Accordingly, the scope

of the claims cannot be readily determined. Though every limitation of the claims has been treated in this office action, correction of this matter is required.

- Claim 1 recites the limitation "the jackpots" in line 12. There is insufficient antecedent basis for this limitation in the claim. It is unclear what "the jackpots" refers to.
- Claim 7 recites the limitation "the second random selection" in line 2. There is insufficient antecedent basis for this limitation in the claim.
- Claim 8 recites the limitation "the second random selection" in line 2. There is insufficient antecedent basis for this limitation in the claim.
- Claim 10 recites the limitation "the top-jackpot step" in line 2. There is insufficient antecedent basis for this limitation in the claim.
- Claim 10 recites the limitation "the base winner" in line 5. There is insufficient antecedent basis for this limitation in the claim.
- Claim 10 recites the limitation "the base jackpot" in lines 5-6. There is insufficient antecedent basis for this limitation in the claim. It is unclear as to which base jackpot the base jackpot refers to.
- Claim 11 recites the limitation "the top-jackpot step" in line 4. There is insufficient antecedent basis for this limitation in the claim.
- Claim 11 recites the limitation "the base winners" in line 5. There is insufficient antecedent basis for this limitation in the claim.
- Claim 11 recites the limitation "the base jackpots" in lines 5-6. There is insufficient antecedent basis for this limitation in the claim. It is unclear as to which base jackpots "the base jackpots" refer to.

- Claim 12 recites the limitation "the top-jackpot step" in line 4. There is insufficient antecedent basis for this limitation in the claim.
- Claim 12 recites the limitation "the base jackpots" in lines 5-6. There is insufficient antecedent basis for this limitation in the claim. It is unclear as to which base jackpots "the base jackpots" refer to.
- Claim 13 recites the limitation "the one-by-one lotto game" in line 2. There is insufficient antecedent basis for this limitation in the claim.
- Claim 13 recites "a select-all-jackpots step for determining the top winner of the top jackpot and the one base jackpot" in lines 4-5. It is unclear as to what the select-all-jackpots step does, if it determines the top winner of the top jackpot and a base winner of the one base jackpot, or if it determines the top winner of the top jackpot and the one base jackpot.
- Claim 14 recites the limitation "the two-by-two lotto game" in line 2. There is insufficient antecedent basis for this limitation in the claim.
- Claim 14 recites the limitation "the select-all-jackpots step" in line 4. There is insufficient antecedent basis for this limitation in the claim.
- Claim 14 recites "a select-all-jackpots step for determining the top winner of the top jackpot and the one base jackpot" in lines 4-5. It is unclear as to what the select-all-jackpots step does, if it determines the top winner of the top jackpot and a base winner of the one base jackpot, or if it determines the top winner of the top jackpot and the one base jackpot.
- Claim 15 recites the limitation "the two-by-two lotto game" in line 2. There is insufficient antecedent basis for this limitation in the claim.

- Claim 15 recites the limitation "the select-all-jackpots step" in line 4. There is insufficient antecedent basis for this limitation in the claim.
- Claim 15 recites "a select-all-jackpots step for determining the top winner of the top jackpot and the one base jackpot" in lines 4-5. It is unclear as to what the select-all-jackpots step does, if it determines the top winner of the top jackpot and a base winner of the one base jackpot, or if it determines the top winner of the top jackpot and the one base jackpot.
- Claim 16 recites the limitation "the number-by-number lotto game" in line 15. There is insufficient antecedent basis for this limitation in the claim.
- Claims 17-20 each recite the limitation of running the first, the second, the third, or the fourth television ad "repeatedly at selected times over a selected period of time." If each "a selected period of time" is the same selected period of time, it should be clearly indicated as such. Otherwise, different terminology should be used for each instance.
- Claim 17 recites the limitations "the ad" in lines 5 and 8, "the cowboy" in lines 5 and 8, "the pickup" in line 5, "the store clerk" in line 6, "the tickets" in line 6, and "the door" in line 8. There is insufficient antecedent basis for these limitations in the claim.
- Claim 18 recites the limitations "the cowboy" in lines 2 and 9, "the country store" in line, "the ad" in lines 4, 5, 8, and 12, "the new red 4 X 4 pickup" in lines 5-6, "the clerk" in line 6, "the pretty girl" in lines 8 and 12, "the tickets" in line 8, and "the door" in line 8. There is insufficient antecedent basis for these limitations in the claim.

- Claim 19 recites the limitation "the ad" in line 4, "the country store" in lines 3 and 5, and "the clerk" in line 5. There is insufficient antecedent basis for these limitations in the claim.
- Claim 20 recites the limitations "the ad" in lines 4 and 6. There is insufficient antecedent basis for these limitations in the claim.
- Re Claims 3 and 5-8: Claim 3 recites "the gaming method includes a random selection of a predetermined plurality of winning numbered balls from a predetermined plurality of a top-jackpot lot of numbered balls" in line 2-4. Similarly, claim 5 recites "a first random selection" in line 2 and "one or more second selections" in line 6, and claim 6 recites "a first random selection" in line 2 and "one or more second selections" in line 6. It is unclear how the gaming method can include a random selection or one or more selections, the term "selections" representing physical elements. If the applicant intended to enumerate a method step, the claim should be worded as such (e.g. selecting...). Claims 7 and 8 are both dependent on claim 6 and both contain both limitations of claim 6.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (US Patent No. 6,086,477) in view of Grippo et al. (US Patent No. 6,017,032).

Re Claim 1: Walker et al. teach a lotto game comprising one top jackpot and one or more base jackpots (X1-X6, Table, Col. 10, Lines 22-37), the top jackpot being structured for receiving a predetermined large portion of prize money, the one or more base jackpots being structured for receiving a predetermined small portion of prize money in proportion to the predetermined large portion (Table, Col. 10, Lines 22-37; Col. 12, Lines 19-35); where, in an example embodiment, the top jackpot is represented by line X1 with a predetermined large portion of prize money equal to $1,000,000, and the one or more base jackpots represented by lines X2-X6 with predetermined small portions of the prize money in the range of $2 to $100,00 (Table, Col. 10, Lines 22-37).

Walker et al. also teach a gaming method for determining a top winner of the top jackpot and for determining one or more base winners for winning the one or more base jackpots respectively (Col. 3, Lines 41-47), and wherein an organizational structure of the jackpots and gaming method employed may be structured for advertising identification with at least one popular item (Col. 2, Lines 41-56).

However, Walker et al. do not specifically teach that the prize money of the top jackpot and the one or more base jackpots are from a net intake from the sale of the lotto tickets.

Grippo et al. teach that the prize money is supplied by the sales of the lottery tickets, and that the controlling agency may retain a portion of the sales for overhead and profit.

Drawings may also be determined at a predetermined time and date, after a period of ticket sales, or by reaching a predetermined number of ticket sales (Col. 4, Lines 16-42).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to award the top jackpot and the one or more base jackpots from portions of the net intake of the sale of the lottery tickets. With the amount of money funding the plurality of jackpots taken directly from the sale of the lottery tickets, the controlling agency is able to control the profit retained from the lottery game.

Re Claim 2: Walker et al. additionally teach that the lottery authority can increase the markup value on ticket prices in order to achieve a desired profit margin (Col. 10, Lines 39-48). Also, the prize amounts can similarly be changed to achieve a desired profit margin (Col. 10, Lines 57-61).

Re Claim 3: Walker et al., as modified by Grippo et al., teach the limitations of claim 1, as discussed above.

Walker et al. additionally teach that the winning numbers for a top-jackpot are selected from a lottery drawing (Col. 1, Lines 32-37), typically using a random number generator in electrical or mechanical form (Col. 12, Lines 53-62)

However, Walker et al. do not specifically teach that the gaming method includes selecting the numbers from a lot of numbered balls.

Grippo et al. teach that the lottery game may be played by picking from numbered balls (Col. 7, Lines 1-6).

Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to use numbered ping pong balls for the number selection of the lottery drawing in Walker et al. The use of numbered balls is a conventional lottery winning selection means for randomly selecting numbers..

Re Claims 4 and 10-12: Walker et al., as modified by Grippo et al., teach the limitations of claim 1, as discussed above.

Walker et al. teach the step of determining and identifying any winners of the lottery game (Col. 3, Lines 44-47) of a plurality of jackpots.

However, Walker et al. do not specifically teach a top-jackpot step for determining the top winner of the top jackpot and one or more base-jackpot steps for determining the one or more base winners of the one or more base jackpots respectively.

Grippo et al. teach that in a lottery game with multiple jackpots, the determining of the winners of the jackpots can be determined separately and sequentially, or simultaneously (Col. 6, Lines 51-67).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a step for determining the top winner and a step for determining the one or more base winners. Since there are distinct criteria for the top jackpot and the one or more base jackpots, determining the winners is accomplished separately.

Re Claims 5-6: Walker et al., as modified by Grippo et al., teach the limitations of claim 4, as discussed above.

Walker et al. do not specifically teach that the jackpot steps include random selections of numbered balls.

Grippo et al. teach that the lottery game may be played by picking from numbered balls (Col. 7, Lines 1-6).

Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to use numbered ping pong balls for the number selection of the plurality of lottery drawings in Walker et al. The use of numbered balls is a conventional lottery winning selection means for randomly selecting numbers.

Re Claims 7-8: Walker et al., as modified by Grippo et al., teach the limitations of claim 6, as discussed above.

Walker et al. additionally teach that the drawings can be made using random number generators including hand drawings and electrical random number generators (Col. 12, Lines 53-62).

Re Claim 9: Walker et al. teach an advertisement method for identifying the lottery game with a popular item (Col. 2, Lines 41-56).

Re Claims 13-15: Walker et al. disclose the limitations of claim 1, as discussed above. Walker et al. additionally disclose the step of determining and identifying any winners of the lottery game jackpots (Col. 3, Lines 44-47; Table, Col. 10, Lines 22-37).

Re Claims 16-20: Claims 16-20 include limitations and language that define the contents of a television advertisement. The "4X4 pickup" of claim 16 (line 17) and the contents of the television advertisements described in claims 17-20 constitute non-functional descriptive matter. The content laid out, essentially a script for the advertisements, is a form of printed matter. The verbiage is not functionally related to the advertising method, and therefore does not carry any patentable weight to distinguish it from the prior art.

The use of advertising content amounts to a mere matter of choice by a user in delivering the advertisement. The specific content does not define patentable subject matter, as this is simply obvious to one of ordinary skill in the art to select language for use in advertising. The specific content clearly is non-functional descriptive matter lending nothing to the claimed subject matter that would render patentable subject matter.

See In re Miller, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969); In re Ngai, 367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004); MPEP § 703.03(a); MPEP § 2112.01(o).

Re Claim 16: Walker et al. teach a lotto game comprising one top jackpot and four base jackpots ("X1-X5" Table in Col. 10, Lines 22-37), the top jackpot being structured for receiving a predetermined large portion of prize money and the four base jackpots being structured for receiving a predetermined small portion of prize money in proportion to the predetermined large portion of the net intake from the sale of the lotto tickets (Table, Col. 10, Lines 22-37; Col. 12, Lines 19-35); where, in an example embodiment, the top jackpot is represented by line X1 with a predetermined large portion of prize money equal to $1,000,000, and the four base jackpots represented by lines X2-X5 with predetermined small portions of the prize money in the range of $2 to $100,00 (Table, Col. 10, Lines 22-37).

Walker et al. also teach a gaming method for determining a top winner of the top jackpot and for determining four base winners for winning the one or more base jackpots respectively (Col. 3, Lines 41-47), wherein the lottery authority can increase the markup value on ticket prices or change the prize amounts in order to achieve a desired profit margin (Col. 10, Lines 39-48; Col. 10, Lines 57-61), and an advertisement method for identifying a lotto game with a popular item (Col. 2, Lines 41-56).

However, Walker et al. do not specifically teach that the prize money for the top jackpot and the one or more base jackpots are from predetermined portions of a net intake from the sale of the lotto tickets.

Grippo et al. teach that the prize money is supplied by the sales of the lottery tickets, and that the controlling agency may retain a portion of the sales for overhead and profit. Drawings may also be determined at a predetermined time and date, after a period of ticket sales, or by reaching a predetermined number of ticket sales (Col. 4, Lines 16-42).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to award the top jackpot and the one or more base jackpots from portions of the net intake of the sale of the lottery tickets. With the amount of money funding the plurality of jackpots taken directly from the sale of the lottery tickets, the controlling agency is able to control the profit retained from the lottery game.

9. Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (US Patent No. 6,086,477) in view of Grippo et al. (US Patent No. 6,017,032), as applied to claim 16 above, and further in view of "12-Foot Gators Don't Faze Star of Lottery Ad" (The Orlando Sentinel, Jan 9, 1988).

Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. in view of "12-Foot Gators Don't Faze Star of Lottery Ad" (The Orlando Sentinel, Jan 9, 1988).

Walker et al. teach the limitations of claim 16, as discussed above.

However, Walker et al. do not specifically teach that the advertisement method includes preparing television advertisements and running the television advertisements.

"12-Foot Gators Don't Faze Star of Lottery Ad" teaches that lottery games can be advertised in the form of television advertisements and prepared and broadcasted in order to promote a lottery game. The lottery advertisement comprises alligators used to promote the Florida lottery.

Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare a plurality of television advertisements and then run the television advertisements. The advertisements advertise the lottery game, providing viewers with interest and information about the lottery game.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Sludikoff discloses a lottery game comprising a method of selecting randomly drawn numbers by picking numbered ping-pong balls.

- Ghela discloses a lottery game including large payout amounts and small payout amounts, where drawings conventionally occur by a random number generator or hand drawing.
- Al-Ziyoud disclose that lottery games can be advertised in media such as television commercials.
- Stanek discloses a lottery game including a plurality of jackpots.

11. This Office action has an attached requirement for information under 37 CFR 1.105. A complete reply to this Office action must include a complete reply to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Cheung whose telephone number is (571) 270-1349. The examiner can normally be reached on Mon-Thurs, 8-4:30, and every other Fri, 8-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KATHLEEN MOSSER
PRIMARY EXAMINER

Requirement for Information

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

Any information known to applicant regarding the advertisement of lottery games and the methods by which they are performed are required to be submitted.

The information is required to extend the domain of search for prior art. Limited amounts of art related to the claimed subject matter are available within the Office, and are not generally found in the classification system. A broader range of art to search is necessary to establish the level of knowledge of those of ordinary skill in the claimed subject matter art of advertising lottery games.

FREDERICK R. SCHMIDT
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